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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,209	12/08/1999	BRADLEY CAIN	120-025	7418
34845 7590 02/05/2009 Anderson Gorecki & Manaras LLP			EXAMINER	
33 NAGOG PA ACTON, MA 0	<del></del>		ZIA, SYED	
ACTON, MA 01/20			ART UNIT	PAPER NUMBER
			2431	
			NOTIFICATION DATE	DELIVERY MODE
			02/05/2009	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)		
	09/457,209	CAIN, BRADLEY		
Office Action Summary	Examiner	Art Unit		
	SYED ZIA	2431		
The MAILING DATE of this communication ap Period for Reply	ppears on the cover sheet with the c	correspondence address		
A SHORTENED STATUTORY PERIOD FOR REPLEWHICHEVER IS LONGER, FROM THE MAILING ID.  - Extensions of time may be available under the provisions of 37 CFR 1 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period.  - Failure to reply within the set or extended period for reply will, by stature Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICATION  .136(a). In no event, however, may a reply be tird  d will apply and will expire SIX (6) MONTHS from te, cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).		
Status				
Responsive to communication(s) filed on 13 I      This action is <b>FINAL</b> . 2b) ☐ This action is <b>FINAL</b> .      Since this application is in condition for allowatelessed in accordance with the practice under	is action is non-final. ance except for formal matters, pro			
Disposition of Claims				
4)  Claim(s) <u>1,2,4-9,11-16,18-22 and 24-26</u> is/are 4a) Of the above claim(s) is/are withdra 5)  Claim(s) is/are allowed. 6)  Claim(s) <u>1,2,4-9,11-16,18-22 and 24-26</u> is/are 7)  Claim(s) is/are objected to. 8)  Claim(s) are subject to restriction and/	awn from consideration.			
Application Papers				
9) The specification is objected to by the Examin 10) The drawing(s) filed on is/are: a) ac Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the E	cepted or b) objected to by the defended or b) for objected to by the defended or by the drawing(s) is objection is required if the drawing(s) is objection is	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).		
Priority under 35 U.S.C. § 119				
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>				
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO/SB/08)  Paper No(s)/Mail Date	4)  Interview Summary Paper No(s)/Mail D: 5)  Notice of Informal F 6)  Other:	ate		

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#### **DETAILED ACTION**

This office action is in response filed on November 13, 2008. Original application contained Claims 1-24. Applicant amended Claims 1-2, 4, 8-9, 15, and 22, and cancelled claims 3, 10, 17, and 23. Therefore, claims 1-2, 4-9, 11-16, 18-22, and 24-26 are pending.

### Claim Rejections - 35 USC § 101

- 1. 35 U.S.C. 101 reads as follows:
  - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
- 2. Claims 15-16, and 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
- 3. Claims 15-16, and 18-21 recite computer program instructions, which is interpreted as software per se, however, the claims fail to assert the program recorded on an appropriate computer-readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer without a computer-readable medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material. See MPEP 2106.01 for details.

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). See MPEP 2106.01.

5. Claims 1-2, 3-7, and 25 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would <u>not qualify</u> as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the <u>particular machine to which it is tied</u>, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.* 

## Allowable Subject Matter

Claim 1-2, 4-9, 11-16, 18-22, and 24-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED ZIA whose telephone number is (571)272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SZ

January 23, 2009 /Syed Zia/

Primary Examiner, Art Unit 2431